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09/472,927
12/27/1999

Examiner: Gravini, Stephen Michael
Group Art Unit: 3622
Atty. Docket: CM01363L

R E M A R K S

In the final office action, the Examiner has restricted the application indicating there are now two inventions based upon the claim amendments filed in the last amendment. Specifically, the application has been restricted to two groups: the first group comprising claims 1-5 and 7-14 while the second group comprises claims 15-18. In that the invention in claims 1-5 and 7-14 was originally examined, these claims were indicated as now provisionally elected. Further, claims 1-14 were rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. Claims 1-5 and 7-14 were rejected under §112(1) as containing subject matter which was not described in the specification in such a way as to reasonably convey that the inventors had possession of the claimed invention. Finally, claims 1-5 and 7-9 and 10-14 were again rejected under § 102(e) as being anticipated by Merriman et al. and d'Eon et al. In this amendment, claim 15 has been amended to correct a typographical error.

As noted in the previous response, the present invention is a system and method for measuring user interaction within a defined space. This space may be advertisement space on a web page of a website on the internet. The system includes at least one server in communication with a network site including one or more defined spaces with each space having a predefined display area. A user computer selectively records interaction data relative to cursor placement and duration on a specifically defined space on the display area. This interaction data is then transmitted to the server hosting the defined space. The invention is novel in that it records not only cursor position but also the time, i.e., duration in which the cursor remains in some predetermined display location.

Restriction Requirement

Although provisionally elected, Applicants wish to traverse the restriction requirement made in the final office action. As the Examiner will note, claims 1 and 15 recite similar inventions. However, the invention defined by claim 1 specifies that the user computer selectively records interaction data relative to cursor placement and time relative to movement. Claim 15 recites that the user computer selectively records interaction data relative to location of the cursor on the display area and the duration upon which the cursor is left at the specific

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location. As noted in MPEP 803, restriction is proper only when the inventions are independent and there is a serious burden on the Examiner if restriction is required. With respect thereto, these inventions are practically identical in recitation and operation. They are neither independent nor are they distinct inventions as required by Rule 121. As noted in MPEP 802.01, “independent” means that there is no disclosed relationship, while “distinct” means that the subjects in the claims are related but capable of separate manufacture, use or sale. The invention as recited in these claims determines the length of time that a cursor remains in some predetermined location. The inventions as recited in the claims are not independent as they both recite differing ways of expressing the same invention. The inventions are not distinct because they are incapable of separate manufacture, use or sale. All of the claims recite aspects of the same invention. Consequently, Applicants assert the claimed invention does not fit either the meaning of “independent” or “distinct” as required by the patent rules.

Moreover, there is no additional searching burden on the Examiner since, presumably, the best art would have been found in the initial search. Although the Examiner has noted that these claims are classified in different areas, classification is only a sub-test of restriction. The Examiner should have the best art on the record and no further search should be required. Thus, there should be no additional time requirement on the Examiner in considering these additional claims. Accordingly, Applicants request the restriction requirement be withdrawn and claims 15-18 be considered along with claims 1-5 and 7-14 as amended.

Rejection under 35 U.S.C. § 101

The Examiner has rejected claims 1-14 under § 101 as claiming subject matter that provides no useful, concrete and tangible result as required by the *Alapatt* and *State Street Bank* cases. Presumably, the Examiner is rejecting claims 1-5 and 7-14 since claim 6 was previously cancelled. The Examiner goes on to indicate that the claimed network, server and user computer interaction contain “recitations of descriptive material that cannot exhibit any functional interrelationship.” As evidenced by the claim language, it is unclear how the Examiner does not see any interrelationship between the claim elements. Each of the independent claims recites a system for measuring user interaction that includes at least one server and at least one user computer in communication with the network. The claims recite that a browser interacts with a

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network site to record interaction data relative to cursor placement as well as time relative to movement. This information is then transmitted to the server.

Surely, all these claim elements “interact.” As noted in the final action, Applicants remain uncertain as to how these claim elements might be deemed as “non-functional descriptive material.” Claims 1, 7 and 15 recite an invention that measures a time period during which a cursor is placed in a display area that produces a useful, concrete and tangible result. For example, the result of the invention might allow marketers to determine advertisements or other display areas which have been dwelled upon by a cursor for some predetermined time. The result is concrete as the invention would determine a definitive amount of time the cursor is in one area. The invention is tangible since it is easily determined and not an abstract value.

Therefore, Applicants suggest that the rejection under § 101 is improper and should be withdrawn. Although the Examiner may prefer claims with more limitations, the present claims as they stand are not non-statutory under § 101 simply because they are short. Should the Examiner have any suggestions on how these claim elements might be better defined to show the interrelationship the Examiner requires, Applicants would surely consider any such suggestion.

Rejection under 35 U.S.C. § 112

The Examiner has also rejected claims 1-5 and 7-14 under § 112(1) as not describing the invention in the specification in such a way as to convey that Applicants had possession of the claimed invention. As noted in the prior response, support for the invention is clearly shown on page 6, line 16, through page 8, line 25, of the instant specification. Applicants’ specification clearly identifies an invention that records time relative to cursor movement. Accordingly, it is difficult for Applicants to suggest or add subject matter if the Examiner does not make specific comments regarding the lack of supporting subject matter. The Examiner continues to insist that the specification merely introduces a “concept,” although the specification clearly defines an invention that works to record time of relative cursor movement. In fact, page 7 of the specification goes on to recite an example of how the invention can be implemented in JavaScript. Thus, Applicants assert that the invention is not a concept but an enabled invention fully supported by the specification. Consequently, Applicants request that the rejection of claims 1-5 and 7-14 under § 112(1) be withdrawn. Should the Examiner maintain his rejection

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on these grounds, Applicants request the he specifically note what portions of the claims are lacking in description so that the appropriate portions of the specification might be reviewed.

Rejection under 35 U.S.C. § 102(e)

That Examiner has maintained his rejection under § 102(e) wherein claims 1-5 and 7-9 were again rejected as being anticipated over Merriman et al. Claims 10-14 have also again been rejected over d'Eon et al. Merriman et al. teach a method for delivery, targeting and measuring of advertising over a network. In Merriman et al., the number of times advertising content is displayed is used to compile statistics for targeting the delivery of advertisements. d'Eon et al. teach a system and method for assessing the effectiveness of an Internet marketing campaign where the number of impressions of web advertisements are correlated with post impression transactional activity to measure effectiveness of advertisements.

It is important that the Examiner recognize that the claims in the present invention define a system and method "for measuring user interaction where a user computer can selectively record interaction data relative to cursor placement and time relative to movement." Neither Merriman et al. nor d'Eon et al. teach a system that has the ability to measure the time during which a cursor remains in one location in a display area. As noted in Merriman et al., Col 2, lines 30-36, the server can "process how many times a user sees various advertisements, how often the advertisement has been seen and start and stop date of the various advertisements." Thus, there is no teaching or suggestion of how long a cursor remains within a predetermined display area. Similarly, in d'Eon et al., Col. 3, lines 37-46, describe a method for utilizing the number of times user computers of a network access one or more advertisements on one or more network sites. Thus, this method in no way determines the duration during which a cursor remains in a predetermined area of a computer display.

Moreover, as noted in both Merriman et al. and d'Eon et al., these systems use a "click through" type action for measuring ad impressions while the present invention uses a cursor position and time type approach. In the art of record, if a user at the client computer does not click on the specific ad area, NO IMPRESSION is generated (Merriman: Col. 3, lines 18-23; Col. 3, line 64 – Col. 4, line 5; Col. 4, lines 43-51, Col. 6, lines 65-68; Col. 7, lines 26-30) and (d'Eon: Col 5, lines 40-48). In contrast, the present invention utilizes an ad impression metric

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that is generated regardless of when the user clicks on the ad area. The invention is based on the movement of the cursor and the time recordation as compared to how many clicks are counted in a specific area.

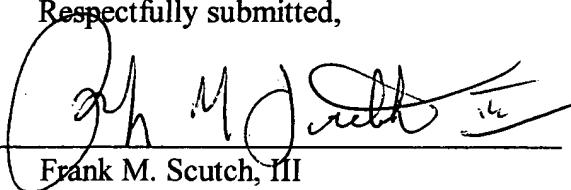
Since the art of record is absent of any teaching on how long a cursor remains in a display area, Applicants respectfully suggest that the rejection under § 102(e) is improper and should be withdrawn. Although the Examiner has mentioned "obviousness" in the "Remarks" section of the final action, no rejection was based upon § 103. Applicants assert that even if an obviousness rejection were made, there is no suggestion in the art of record for measuring cursor placement and time relative to movement on a specific defined space. As noted above, should the Examiner have any comments or suggestions to better define the present invention, he is invited to telephone the undersigned to discuss adding these claim limitations.

Accordingly, this application is now believed to be in proper form for allowance. An early notice of allowance is respectfully requested. No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Please charge any additional fees associated with this amendment and credit any overpayments to Deposit Account No. 50-0223. A duplicate original of this sheet is enclosed.

Respectfully submitted,

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